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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,785	01/12/2004	Hoon Chung	P/3940 - 19	2927

2352 7590 05/26/2006

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EXAMINER	
FEELY, MICHAEL J	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/756,785	CHUNG ET AL.	
	Examiner	Art Unit	
	Michael J. Feely	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 2* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/929,457.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *0104*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Pending Claims

Claims 1 and 2 are pending.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/929,457, filed on August 14, 2001.

Claim Objections

2. Claim 1 is objected to because of the following informalities: "propyleneglcol" should be replaced with --propyleneglycol--. Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,743,837 (Chung et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

- The patented claim does not explicitly disclose *"an epoxy equivalence in a range of about 900-1200;"* however, the Specification (see column 9, lines 19-25) discloses that this range is exemplary and preferred. In light of this, it has been found that, "Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent – *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in *Vogel* recognized 'that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim,' but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first 'determine how much of the patent disclosure pertains to the invention claimed in the patent' because only '[t]his portion of the specification supports the patent claims and may be considered.' The court pointed out that 'this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under **35 U.S.C. 103**, since only the disclosure of the invention claimed in the patent may be examined.'" – *see MPEP 804 II B 1.*

- The patented claim recites, *"(b) about 26% by weight of an anticorrosive pigment;"* however, after reviewing the prosecution record of this patent, this appears to be a typographical error. The claims allowed on January 23, 2004 disclosed a range of *"about 2-6%."*

5. Claim 2 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,743,837 (Chung et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

- The teachings of patented claim 4 anticipate the pigment paste of instant claim 2.

6. Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-12 of U.S. Patent No. 6,476,102 (Chung et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

- The combined teachings of patented claims 9-12 anticipate the pigment pastes of instant claims 1 and 2.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sikora (US Pat. No. 6,156,823).

Regarding claim 2, Sikora discloses: ***(A)*** a pigment paste composition comprising: about 15-30% by weight of pigment grinding vehicle; and about 2-6% by weight of an anticorrosive pigment, wherein the anticorrosive pigment is anyone selected from the group consisting of bismuth hydroxide, bismuth trioxide, bismuth oxide, aluminum tri-polyphosphate hydrate and magnesium aluminum hydroxide carbonate hydrate; wherein a ratio of solid content of said pigment/pigment grinding vehicle is about 1/0.2-1/0.45 (column 5, lines 10-16 and 57-67; column 6, lines 1-25; column 6, line 46 through column 7, line 47); and ***(B)*** a pigment paste

composition comprising: about 15-30% by weight of pigment grinding vehicle; and about 0.7-2.3% by weight of dibutyl tin oxide; wherein a ratio of solid content of said pigment/pigment grinding vehicle is about 1/0.2-1/0.45 (column 5, lines 10-16 and 57-67; column 6, lines 1-25; column 6, line 46 through column 7, line 47).

The teachings of Sikora demonstrate that bismuth trioxide is an environmentally friendly substitute for dibutyl tin oxide in pigment pastes of aqueous cathodic electrocoating compositions (column 1, line 56 through column 2, line 20; column 5, line 10 through column 8, line 43). Sikora discloses, "The above results show that Baths 3 and 4 containing the bismuth trioxide catalyst had solvent resistance *equal to* the metal catalyst of dibutyl tin oxide under normal baking conditions and is an acceptable catalyst. It does not have acceptable solvent resistance when under baked. The corrosion-resistance data shows that Bath 4 containing the bismuth trioxide had acceptable corrosion resistance as did Baths 1 and 2 which contained dibutyl tin oxide as the catalyst," (column 8, lines 35-43). In other words, this data demonstrates that bismuth trioxide and dibutyl tin oxide are equivalents as anti-corrosive catalysts in pigment pastes.

In light of this, it has been found that, "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art," – *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use both bismuth trioxide and dibutyl tin oxide in the pigment pastes of Sikora

because the teachings of Sikora demonstrate that bismuth trioxide and dibutyl tin oxide are equivalents as anti-corrosive catalysts in pigment pastes. The idea of combining them flows logically from their having been individually taught in the prior art.

Allowable Subject Matter

11. Claim 1 would be allowable: (A) with a timely filed terminal disclaimer; or (B) if rewritten or amended to overcome the nonstatutory obviousness-type double patenting rejection(s) set forth in this Office action.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael J. Feely
Primary Examiner
Art Unit 1712

May 24, 2006

MICHAEL FEELY
PRIMARY EXAMINER